

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-3, 5-14 and 16-21 are presently active in this case. The present Amendment amends independent Claims 1 and 11, and adds new Claim 21 without introducing any new matter, and cancels Claims 4 and 15 without prejudice or disclaimer.

Claims 1-20 were rejected under 35 U.S.C. §102(e) as anticipated by Foladare et al. (U.S. Patent No. 5,905,777, herein "Foladare").

To clarify Applicants' invention, Claim 1 is amended to recite "information processor is further configured to retrieve sub-networks available to provide the requested service based on the different services identified from the database,"¹ and to recite "the different services including protocol translations required to provide the requested service."² Independent Claim 11 is amended to recite similar features in the context of a method. Dependent Claim 3 is also amended for clarification purposes. Claims 4 and 5 are cancelled.

To vary the scope of protection recited in the claims, new Claim 21 is added. New Claim 21 depends upon Claim 1 and recites "wherein the information on the service to be executed includes protocol attributes," and finds non-limiting support in Applicants' specification, for example at page 10, lines 18-22, and therefore does not raise any questions on new matter.

In light of the amendments to independent Claims 1 and 11, Applicants respectfully traverse the rejection of Claims 1-20 under 35 U.S.C. §102(e) over Foladare, and request reconsideration of this rejection, as discussed next.

Briefly recapitulating, independent Claim 1 is directed to an information processor configured to receive a service request message from a first sub-network, the service-request

¹ Finds non-limiting support in Applicants' specification, for example at page 8, lines 15-16.

² Idem at page , lines 7-10.

message including information on a service to be executed, the information processor configured to identify the service; and an information database connected to the information processor, the information database configured to identify the different services associated with the sub-networks, *the different services including protocol translations required to provide the requested service*, that are accessible as part of the network, wherein the information processor is further configured to retrieve sub-networks available to provide the requested service *based on the different services identified from the database*, and initiate a message to establish a communication link with at least one of the identified services that are capable of providing the service. Amended independent Claim 11 recites similar features in the context of a method for identifying a sub-network.

As explained in Applicants' Specification from page 4, line 30 to page 5, line 7 with corresponding Figures 2-4, Applicants' invention improves upon background communication networks having multiple sub-networks because the claimed device provides seamless and efficient communication of services between different constituent parts of a network and can prevent inefficient accessibility of services from users of a different network.

Turning now to the applied reference, Foladare discloses a communication system including an E-mail server and an E-mail network, in which useful E-Mail messages can be identified, separated from junk mail, and forwarded as directed by the recipient.³ However, Foladare fails to teach or suggest

said information processor is further configured to retrieve sub-networks available to provide the requested service *based on the different services identified from the database*

as recited in amended, independent Claim 1. Foladare teaches that "E-mail messages are transmitted over an E-Mail network routed to an E-Mail server servicing the recipient, where useful E-Mail messages can be identified, separated from the junk mail, and forwarded

³ See Foladare in the Abstract.

as directed by the recipient.”⁴ Foladare further explains that the E-Mail server receives an E-Mail message and then accesses the recipient’s record from the database 62.⁵ In addition, Foladare’s step 406 determines if the sender ID 233 in the received message 239 matches any of the senders in the sender list 252 of the recipient’s record.⁶ An E-Mail server accessing a recipient’s record from the database as taught by Foladare, *is not* an information processor configured to retrieve sub-networks available to provide the requested service *based on the different services identified from the database*, since Foladare merely accesses the database for the recipient records.

Applicants further respectfully submit that Foladare fails to teach or suggest the information database configured to identify the different services associated with the sub-networks, *the different services including protocol translations required to provide the requested service*

as further recited in Applicants’ amended independent Claim 1. Foladare teaches that “E-mail messages are transmitted over an E-Mail network routed to an E-Mail server servicing the recipient, where useful E-Mail messages can be identified, separated from the junk mail, and forwarded as directed by the recipient.”⁷ Email forwarding or deletion, as taught by Foladare, *are not* protocol translations required to provide the requested service by a requester, as recited in amended Claim 1. Foladare also describes that a server transmits an alert signal, in form of a summary of a message, to a pager attached to a recipients computer, and further states that “[t]he recipient can view the sender’s name and the title of the message ... and can send a selection signal to the server to forward the message to one of several destinations.”⁸ A summary of a message sent to a recipient, thereby forwarding a selection signal to an E-mail server, as taught by Foladare, *is also not* a protocol translations required to provide the requested service by a requester.

⁴ See Foladare at column 1, lines 43-46.

⁵ See Foladare at column 4, lines 55-64, and in Figures 2 and 4.

⁶ See Foladare from column 4, line 65 to column 5, line 10.

⁷ See Foladare at column 1, lines 43-46.

⁸ See Foladare at column 2, lines 26-30.

Applicant also respectfully disagrees with the outstanding Office Action, stating that Foladare “inherently comprises a protocol converter, wherein the text data of the message is converted to binary and stored.”⁹ A person of ordinary skill in telecommunications art knows that converting text data to binary *is not* a protocol conversion for a communication network having multiple sub-networks.

The outstanding Office Action seems to use improper hindsight by rejecting Appellants’ Claim 12 by constructing a solution based on the teachings of Appellants’ claims. See In re Lowry, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) to recite “[t]o establish a prima facie case of obviousness, the burden of establishing the absence of a novel, nonobvious functional relationship rested with the Patent and Trademark Office,” and “[t]he claimed invention involved an organization of information and its interrelationships that the prior invention neither disclosed nor suggested.” See also Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998).

Further, Applicants also respectfully submit that Foladare fails to teach or suggest all the features of Applicants’ dependent claims, as next discussed.

Regarding new dependent Claim 21, Foladare fails to teach or suggest that the information on the service to be executed includes protocol attributes. Foladare merely explains that E-mail messages are sent, and that forwarding destinations can be chosen by a recipient of the E-mail,¹⁰ and Foladare’s email messages merely includes destination address 232, sender ID 233, title 235, and the E-mail message data 237.¹¹ Foladare is silent on protocol attributes included in the information of the service-request message.

⁹ See the outstanding Office Action at page 5, lines 3-5.

¹⁰ See Foladare in the Abstract.

¹¹ See Foladare at column 4, 15-17.

Regarding dependent Claim 3, the outstanding Office Action teaches that another information processor connected to the information processor and this information processor configured to retrieve information from another database is an inherent feature.¹² First, Applicants respectfully submit that this position is insufficient to show that Foladare's E-mail server 60 inherently teaches the claimed another information processor because it fails to show "that the alleged inherent characteristic *necessarily* flows from the teachings of the applied references."¹³ Second, amended Claim 3 now recites that another information processor is configured to retrieve information from another database to identify sub-networks that perform the requested service *based on the different services identified from the another database*. Foladare merely recites that a recipient can send a selection signal to the E-mail server to forward the message to one of several destinations as discussed above.¹⁴ Foladare is silent on an information processor configured to retrieve information from another database to identify sub-networks that perform the requested service, as recited in amended, dependent Claim 3.

Therefore, the applied reference fails to teach or suggest every feature recited in Applicants' claims, so that Claims 1-3, 5-14 and 16-21 are patentably distinct over Foladare. Accordingly, Applicants respectfully traverse, and request reconsideration of, the rejection based on Foladare.¹⁵

¹² See the outstanding Office Action at page 3, lines 4-9.

¹³ See MPEP 2112 (emphasis in original) (citation omitted). See also same section stating that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic," (emphasis in original). See also In re Robertson, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) ("[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,'" citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient," Id. at 1269 (citation omitted)).

¹⁴ See Foladare for example at column 2, lines 24-37.

¹⁵ See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

Consequently, in view of the present Amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-3, 5-14 and 16-21 is earnestly solicited.

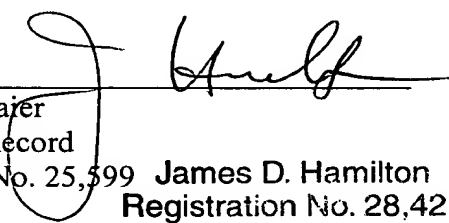
Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

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